

**REMARKS****Claim Status**

Claims 1-21 are pending in this application, with claims 13-21 being withdrawn from consideration. Claims 1-12 are currently under consideration.

Applicant gratefully acknowledges the Examiner's withdrawal of the previous rejections of claims 1-12 under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,099,469 ("the '469 patent").

**Double Patenting**

The sole remaining rejection in this case is based on obviousness-type double patenting. Specifically, the Examiner has maintained the rejection of claims 1-12 based on the judicially created doctrine of obviousness-type double patenting over claims 23-30 and 37-38 of the '469 patent in view of Lillig et al. (US Patent No. 4,965,049). As set forth in the February 28, 2005 Office Action, the Examiner argues that the '469 patent "differs from the instant invention in failing to disclose an automated sample handling device coupled between the analyzers," but that it would have been obvious "to incorporate an automated handling device as taught by Lillig between the analyzers in the system taught by [the '469 patent] to thus, allow sharing fluid transfer therebetween, because it allows for the system to operate as a single system having the advantage of increased capacity and versatility."

Applicants respectfully assert that this rejection improper for at least the reason that the Examiner has failed to establish that each and every limitation of the present claims is

taught or suggested by either the claims of the '469 patent or by Lillig, alone or in combination. For example, independent claims 1, 9 and 10 of the present application each recite the limitation:

“wherein at least one of the plurality of paths of biochemical marker measurement steps includes an immunoassay measurement type and/or a clinical chemistry measurement type not required by another of said plurality of paths of the biochemical marker measurement steps.”

As explained in Applicant's October 10, 2003 submission, this aspect of the claims requires that at least one of the paths in the hierarchical decision-tree does not require performing at least one distinct measurement type that is required by another path, thereby eliminating the need to perform additional and distinct assays that may be unnecessary for providing a diagnosis or indication of pathology. Applicant fails to find any teaching or suggestion of this limitation in Lillig or claims 23-30 and 37-38 of the '469 patent.

Applicant respectfully reminds the Examiner that well-established Federal Circuit case law prohibits resort to the common specification of the '469 patent to provide this limitation. See Geneva Pharmaceuticals, Inc. v. GlaxoSmithKline PLC, 349 F.3d 1373, 1385 (Fed. Cir. 2003) (“Because nonstatutory double patenting compares earlier and later claims, an earlier patent's disclosure is not available to show nonstatutory double patenting.”); Quad Environmental Technologies Corp. v. Union Sanitary District, 946 F.2d 870, 873-74 (Fed. Cir. 1991) (“Only the claims are compared in a rejection for double patenting. Such a rejection by the patent office does not mean that the first-filed patent is a prior art reference under § 102 against the later-filed application.”); In re Kaplan, 789 F.2d 1574, 1579 (Fed. Cir. 1986) (“[T]he patent disclosure may not be used as prior art” in answering the question “[d]oes any claim in the

application define merely an obvious variation of an invention disclosed and claimed in the patent?”); General Foods Corp. v. Studiengesellschaft Kohle mbH, 972 F.2d 1272; 1280-81 (Fed. Cir. 1992). (“Our precedent makes clear that the disclosure of a patent cited in support of a double patenting rejection cannot be used as though it were prior art, *even where the disclosure is found in the claims.*”).

For at least the foregoing reasons, Applicant respectfully submits that the combination of Lillig and the ‘469 patent claims 23-30 and 37-38 do not teach or suggest every limitation of the present claims. For at least this reason, the obviousness-type double patenting rejection of claims 1-12 is improper. Accordingly, Applicant respectfully requests that this rejection be withdrawn and the application passed to allowance.

Finally, should the Examiner determine to maintain the rejection, Applicant kindly requests that the Examiner point to a specific *claim* of the ‘469 patent or specific teaching of Lillig for a teaching of the limitation “wherein at least one of the plurality of paths of biochemical marker measurement steps includes an immunoassay measurement type and/or a clinical chemistry measurement type not required by another of said plurality of paths of the biochemical marker measurement steps” so the record is clear for appeal.

**Conclusion**

In view of the foregoing, allowance of all pending claims is respectfully requested. If any outstanding issues remain, or if the Examiner has any suggestions for expediting allowance of this application, the Examiner is invited to contact the undersigned at the telephone number below.

Respectfully submitted,  
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